

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claims 28 to 30, claims 2 to 10, 12 to 17, 27 and 31 are currently pending. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, Applicants once again respectfully request acknowledgment of the claim for foreign priority and an acknowledgment that a certified copy of the priority application was filed in the parent application, i.e., U.S. Patent Application Serial No. 09/971,504.

### **II. Objection to the Specification**

As regards the objection to the Specification, it is respectfully submitted that the phrase "that is configured to fill one of a pore and a score of average size on a braking surface of the brake device upon abrading the corrosion protective coating by a brake lining during braking" does not constitute new matter. In this regard, the Specification as originally filed states that "[d]uring removal by braking the protective substances are, at least partially, for example, pressed and/or rubbed into the surface of the braking surface, where they remain and further effect protection of the metallic surface from oxidation." Specification at p. 2, lines 20 to 23. The Specification as originally filed further states that "[b]y the introduction of the protective substances into the surface rough spots, pores and score marks of the braking surface, the normal surface roughness of the braking surfaces, which results due to the natural pores of the brake disk material and/or grinding or turning score marks, is reduced at the same time." Specification at p. 3, lines 1 to 6. The Specification as originally filed further states "[i]n order to achieve a particularly satisfactory result, the average particle size of the protective substances may be smaller than the maximum roughness and/or the average pore width and/or the average score mark size of the braking surface." Specification at p. 3, lines 9 to 13. Applicants respectfully submit that it is clear from the above that the Specification as originally filed discloses protective substances configured so as to be able to be pressed and/or rubbed into the braking surface. Therefore, the phrase "that is configured to fill one of a pore and a score of average size on a braking surface of the brake device upon abrading the corrosion protective coating by a brake lining

during breaking” does not constitute new matter. In view of the foregoing, withdrawal of this objection is respectfully requested.

### **III. Rejection of Claim 31 Under 35 U.S.C. § 112, 1<sup>st</sup> ¶**

Claim 31 was rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. As an initial matter, the Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). As detailed above, the Specification clearly supports the phrase “that is configured to fill one of a pore and a score of average size on a braking surface of the brake device upon abrading the corrosion protective coating by a brake lining during breaking,” as recited in claim 31. Nowhere does the Office Action provide reasons why a person skilled in the art would not recognize the description of this language in the disclosure of the application, as detailed above. Therefore, the Office Action has failed to satisfy the initial burden in rejecting claim 31 for lack of written description.

Further, the written description requirement is not an in haec verba requirement. That is, “the specification ‘need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.’” All Dental Prodx LLC v. Advantage Dental Products Inc., 64 U.S.P.Q.2d 1945, 1948 (Fed. Cir. 2002) (quoting Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995). Moreover, a “failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” All Dental Prodx, 64 U.S.P.Q.2d at 1948 (citing Eiselstein, 52 F.3d at 1039, 34 U.S.P.Q.2d at 1470). Therefore, the use of the phrase “configured” in claim 31 does

not require use of the identical language in the Specification given that the Specification makes clear to one skilled in the art that the protective substance may be used to fill pores and scores on the braking surface and that may be specifically sized to fit in the pores and scores.

Therefore, for the foregoing reasons, it is respectfully submitted that claim 31 fully complies with the written description requirement of 35 U.S.C. § 112, first paragraph, and withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claims 2 to 10, 12 to 17 and 27 Under 35 U.S.C. § 112, 1<sup>st</sup> ¶**

Claims 2 to 10, 12 to 17 and 27 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Specifically, the Office Action alleges that the application does not provide guidance as to the grain size encompassed by the limitation “substantially equally to at least one of a maximum roughness, an average pore diameter and an average size of score marks.” Applicants respectfully submit that the present claims fully comply with the enablement requirement for the following reasons.

The Office Action’s assertions do not reflect the proper standard for determining whether a patent application complies with the enablement requirement that the Specification describe how to make and use subject matter that is defined by the claims. This standard may not be based on the subjective beliefs of an examiner, but must be based on reasonable arguments that are supported by proper evidence. The Supreme Court established the appropriate standard as requiring the establishment by proper evidence of whether **any experimentation for practicing the invention was undue or unreasonable**. See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988)). Thus, the enablement test is whether “one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art *without undue experimentation*.” See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988)).

The Federal Circuit has also stated that there are many factors to be considered in determining whether a specification satisfies the enablement requirement. These factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary

skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. See id (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). The Federal Circuit has further stated that it is “*improper* to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that an examiner’s analysis must “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” See M.P.E.P. § 2164.01.

It is respectfully submitted that one reasonably skilled in the art could make or use the subject matter recited in claims 2 to 10, 12 to 17 and 27 based on information contained in the present application coupled with information known in the art without undue experimentation. The size of roughness, average pore diameter and average score marks on a braking surface of a brake disk and brake drum was known to one ordinary skill in the art at the time of filing of the application. Therefore, one skilled in the art would not have to unduly experiment to make a protective substance made from the various materials disclosed in the application having an average grain size sized to be substantially equal to at least one of a maximum roughness and an average size of score marks of the brake disk and brake drum, as required by claim 10. Withdrawal of this rejection is therefore respectfully requested.

**V. Rejections of Claims 2 to 10, 12 to 17 and 27 Under 35 U.S.C. § 112, 2<sup>nd</sup> ¶**

Claims 2 to 10, 12 to 17 and 27 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Applicants respectfully submit that the claims fully comply with the definiteness requirement for the following reasons.

The Office Action alleges that the term “coating” in claims 12 to 17 and 31 is indefinite and misdescriptive. While Applicants may not agree with the merits of the present rejection, to expedite prosecution, claims 12 to 17 and 31 have been amended herein without prejudice to change “coating” to --coating composition-- consistent with the Office Action’s suggestion.

The Office Action further alleges that the independent claims are unclear as to the grain size encompassed by the phrase “substantially equal to at

least one of a maximum roughness, an average pore diameter and an average size of score marks.” Applicants respectfully disagree for the following reasons.

As stated in M.P.E.P. § 2173.02, the “focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision.” In this regard, the “essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” *Id.* (emphasis added). “Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, inter alia, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Id.* If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more. M.P.E.P. § 2173.05(a) (citing Shatterproof Glass Corp. v. Libbey Owens Ford Co., 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)). Based on the foregoing, it is respectfully submitted that the recited grain size would have been reasonably clear to one of ordinary skill in the art at the time of filing the present application. As indicated above, the size of roughness, average pore diameter and average score marks on a braking surface of a brake disk and brake drum was known to one ordinary skill in the art at the time of filing of the application. Therefore, the recitation of a grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks would have been reasonably clear to one of ordinary skill in the art.

Therefore, the present claims are sufficiently definite. Withdrawal of this rejection is therefore respectfully requested.

**VI. Conclusion**

Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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